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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/540,245 03/31/00 GOODMAN

023379 HM12/0911  
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EXAMINER
C B98-031-5

ART UNIT	PAPER NUMBER
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MCKELVEY, T

DATE MAILED:

1636

09/11/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/540,245

Applicant,  
Goodman et al.

Examiner  
Terry A. McKelvey

Group Art Unit  
1636



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 8-21 28 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 8-21 28 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**DETAILED ACTION**

***Priority***

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) and 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

In the instant case, the reference is misplaced. The reference must be amended to place it at the first sentence of the specification.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described

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in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 8-27 are genus claims because they are drawn to mixtures that contain a Robo polypeptide, which polypeptide appears to be a genus of polypeptides, although that is unclear because the definition of "Robo polypeptide" is unclear as set forth in the rejection below. The sequence of exemplary Robo polypeptides are not set forth in the specification, but are referred to in Kidd et al (1998) and USSN 08/971,172, for drosophila 1, 2; C elegans, human 1, 2; and mouse 1. There is no description of the amino acids that can be altered in Robo polypeptides without losing Robo activity and there is no description of the Robo sequences which are a characteristic of Robo polypeptides. In essence, there is no description of the structure of Robo polypeptides that defines the genus. The general knowledge in the art concerning alleles and homologues does not provide any indication of how the structure of the Robo polypeptides referred to is representative of unknown alleles and homologues. The nature of alleles and homologues is that they are variant structures, and in the present state of the art the structure of one does not provide guidance to the structure of

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the others. The common attributes of the genus are not described. One of skill in the art would conclude that applicant was not in possession of the claimed genus because a description of several members of this genus (referred to in the specification, but whose structures are not set forth) is not representative of the variants of the genus and is insufficient to support the claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 8, etc, the use of "Slit polypeptide" renders the claims vague and indefinite because there is no clear art-recognized definition of this term and the specification fails to set forth a clear definition. Although the Slit polypeptides are set forth in the claims as comprising specific sequences, it is unclear whether polypeptides comprising those

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sequences all are considered to be Slit polypeptides, or whether "Slit" confers additional limitations to the polypeptides. Clearly identifying what polypeptides are encompassed by "Slit polypeptide" would be remedial. For the purpose of examination, no further limitation than the sequence limitations were read into "Slit polypeptide".

With regard to claim 8, etc, the use of "Robo polypeptide" renders the claims vague and indefinite because there is no clear art-recognized definition of this term and the specification fails to set forth a clear definition. Clearly identifying what polypeptides are encompassed by "Robo polypeptide" would be remedial. For the purpose of examination, "Robo polypeptide" was considered to be a polypeptide that has the binding properties of Robo, i.e., specifically binds to a full length Slit polypeptide as defined above.

#### ***Double Patenting***

Claims 27 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 26. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the

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other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The phrasing of the two claims appears to be identical.

### **Conclusion**

No claims are allowed.

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014.


NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terry A. McKelvey whose telephone number is (703) 305-7213. The examiner can normally be reached on Monday through Friday, except for Wednesdays, from about 6:30 AM to about 5:00 PM. A phone message left at this number will be responded to as soon as possible (usually no later than 24 hours after receipt by the examiner).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. George Elliott, can be reached on (703) 308-4003.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Terry A. McKelvey, Ph.D.  
Primary Examiner  
Art Unit 1636

September 10, 2000